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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/318,447	05/25/1999	PERI HARTMAN	23984-12275	1430
758	7590	02/02/2009	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			FADOK, MARK A	
ART UNIT	PAPER NUMBER			
		3625		
MAIL DATE	DELIVERY MODE			
02/02/2009	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/318,447	<b>Applicant(s)</b> HARTMAN ET AL.
	<b>Examiner</b> MARK FADOK	<b>Art Unit</b> 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 29 December 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 108-117,124,125,151-155,157 and 176-183 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 108-117,124,125,151-155,157,176-183 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 9/29/2008, which was received 12/29/2008. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Acknowledgement is made to the amendment to claims 108,113,117,151,154,155,176,180, and 183 and the cancellation of claims 118-123,126-150156,158-175, leaving claims 108-117,124,125,151-155,157,176-183 as pending in the instant application. Applicant's amendment and remarks have been carefully considered and were found persuasive, however, after further search and consideration the following new ground of rejection necessitated by amendment follows:

***Examiner's Note***

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 108,151,176 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the subject claims provide for a log in of the user to the server system, however, applicant's disclosure page 7, lines 15-22 states: "If the purchaser wants to verify the shipping address, the purchaser can select the "check shipping address" label. In response to this selection, the server system may require the purchaser to perform a "login" so that the identity of the purchaser can be verified before the shipping information is viewed or modified. The server system then sends a Web page to the client system for display and possible modification of the shipping address. In this way, the transmitting of the sensitive shipping address can be avoided unless requested by the verified purchaser". This disclosure clearly indicates that the user is in communication with the server and that the log in is not to gain access to the server, but to information that is present on the server. For the purpose of this office action "log in" will be interpreted as "to gain access to a...program....by identifying oneself with a user password" (Microsoft Computer Dictionary Fourth Edition).

Claims 117,155 and 183 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, none of the sections (FIG 4, page 6, line 11 – page 7, line 22 or page 11, lines 13-27) of the instant disclosure describe that a shopping cart model is provided in response to determining that that single-action ordering is disabled. What is disclosed is that a web page is provided that may or may not include a shopping cart model and that the single action is only provided when the single action ordering is enabled, but there is no disclosure that the inclusion of the shopping cart model is determined based on whether or not single action ordering is enabled. As shown in FIG 4 the shopping cart model is already selected and it is later determined whether to add the single action to the web page based on determining that the single-action is enabled.

The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Claims 117,155 and 183 are rejected under 35 U.S.C. 112, fourth paragraph, as failing to comply with further limiting the subject matter of the previous claim(s). In this

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case the functional limitations of the independent claims have been disabled and therefore no longer actively part of the limitations of the combined claims. This claim creates a new independent claim that impermissibly broadens the claim to a detection feature and providing a shopping cart model that may be used to order the item. The examiner cannot therefore address this feature since it is unclear how the features of claims 108,151,176 are further limited by the features of claims 117,155, and 183 after all the features of the independent claims have been obviated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 108-113, 117,124,125, 151-155,157,176-180,183 are rejected under 35 U.S.C. 102(e) as being anticipated by Kirsch (US 5,963,915) in view of Levy (article see PTO 892, recaptured from IDS dated 1/12/2009 in copending case 11618452).**

**In regards to claim 108,151,176** Kirsch discloses a method in a client system for ordering an item, the method comprising:

receiving from a server system a client identifier of the client system (cookie data col 8, lines 10-20); persistently storing the client identifier at the client system (Abstract);

for an item to be ordered, providing for display information identifying the item and an indication of a single action that is to be performed to order the identified item (col 8, lines 64 - col 9, lines 4); and

in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier (col 8, lines 10-35),  
without a user having to log in to the system (col 5, lines 15-20).

Kirsch teaches that a one click order request is provided to a server that includes sending to the server system a request to order the identified item and the client identifier and identifying account information of the user (col 8, lines 13-20) that gathers all the information required to execute a transaction and then providing a confirmation page to the customer to confirm that the order is correct before being processed (col 9, lines 1-3). Kirsch further implicitly contemplates an order being purchased with just one of the phases in that Kirsch states "the entire purchase transaction requires no more than two mouse clicks" (col 11, lines 12-15, meaning less than two clicks is anticipated). However, Kirsch does not explicitly teach that there is one step ordering and a confirmation page is not sent to the buyer. Levy teaches "You're cruising the Net, hopping from link to link with your favorite browser. In a small window in the corner of your screen sits a ledger. "\$100.00," it reads. As you land on a favorite Web site, something strikes your fancy--an annotated bibliography of every article ever written about Sandra Bullock! Only five bucks. You click on a button, and the file is downloaded to your computer. That tiny ledger on your screen now reads "\$95.00."" which consummates and order without a confirmation page (Levy, page 1). It would have been

obvious to a person having ordinary skill in the art at the time of the invention to include in Kirsch processing the order without a confirmation step, because this would remove redundant user input when staging a transaction over the internet (Kirsch, col 4, lines 65-67) and thus save time by the user.

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art . Thus such a combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

the client identifier identifying account information previously supplied by a user of the client system (col 8, lines 13-20); and

responsive to changing account information,  
coordinating the log in of the user to the server system; receiving updated account information (col 14, lines 60-65, see also USC 112 for interpretation of claim element)

sending the updated account information to the server system (col 5, lines 22-27 and col 14, lines 45-65).

The feature in claim 176, "generating an order for the identified item using the account information associated with the received client identifier" can be found in Kirsch FIG 3, item 82, col 8, line 10-35 and col 14, lines 1-20. For the feature in claim 176, "updating the account information associated with the client identifier of the logged in user based on the received updated account information" see Kirsh, col 14, lines 55-65.

**In regards to claim 109,152,177** the combination of Kirsch and Levy teaches wherein the account information includes billing information (Kirsch, col 12, line 55 – 67).

**In regards to claim 110,153,178,** the combination of Kirsch and Levy teaches wherein the account information includes shipping information (Kirsch, col 12, line 55 – 67).

**In regards to claim 111,179,** the combination of Kirsch and Levy teaches wherein the client system and server system communicate via the Internet (Kirsch, FIG 1).

**In regards to claim 112,** the combination of Kirsch and Levy teaches receiving from the server system a confirmation that the order was generated (Kirsch, col 8, lines 25-34).

**In regards to claim 113,154,180,** the combination of Kirsch and Levy teaches the single action is clicking a mouse button for a cursor is positioned over a predefined area of the displayed information" (Kirsch, col 1, lines 40-53).

**In regards to claim 124,125,157,** the combination of Kirsch and Levy teaches a display screen for providing information interactively with a user and permitting cancellation of orders, but does not specifically mention that the information provided is an indication that the order for the item that is requested in response to performing the single action can be canceled within a time period (i.e. "You can cancel within 90 minutes" (applicant's drawing FIG 1A)). However, these differences are only found in the non-functional data provided. Data displayed on a web page providing information is not functionally related to the substrate of the invention. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide information such as "You can cancel within 90 minutes" as part of the graphical and text information on a web page as is taught by

Kirsch (Kirsch, col 1, lines 40-45, quality text and graphical based information), because such data does not functionally relate to the substrate of the invention and merely labeling the information provided on the web page differently from that in the prior art would have been an obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

**Claims 117, 155,183 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch (US 5,963,915) in view of Levy and further in view of Admitted Prior Art ((APA) see applicant's disclosure) in view of Franklin (US 6,125,352, see IDS received 1/12/2009 item A51).**

**In regards to claim 117, 155,183,** the claim states "in response to determining that single action ordering is disabled, providing a shopping cart model that may be used to order the item".

Please note that the phrase "that may be used to order the item" is given little patentable weight since it is a mere stating of intended use of the old and well known shopping cart model.

The description of the use of a shopping cart model is only found in applicant's disclosure FIG 4, page 6, line 11 – page 7, line 22 or page 11, lines 13-27.

The combination of Kirsch and Levy teach providing conventional purchasing methods when a secure transaction is not enabled (Kirsch, FIG 3, items 56 and 57) and

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providing an alternative means to purchase the product when the single action ordering is not enabled (Kirsch, FIG 3, item 68 and 70). Kirsch further teaches sending web pages with hyperlinks that can access other web pages (Kirsch, col 1, lines 30-65), but does not specifically mention that a shopping cart model is provided when the one click ordering method is disabled. APA teaches that one skilled in the art would know to add a shopping cart model to a web page (APA, page 6, lines 15-20) and that one skilled in the art would further appreciate that a single web page on the server system may contain a shopping cart model and a one-click model on a single web page (APA, page 6, lines 28,29). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Kirsch providing a shopping cart model when a one-click method is not enabled as is taught by the combination of Kirsch's determining and APA's availability of a shopping cart, because this will provide an additional opportunity to complete the sale and increase revenues to seller when one method is preferred or not available.

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art. Thus such a combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or

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motivation is required to support a finding of obviousness. See the recent Board decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

As an alternative rejection Kirsch teaches a one-click method and providing conventional purchasing methods when a secure transaction is not enabled (Kirsch, FIG 3, items 56 and 57) and providing an alternative means to purchase the product when the single action ordering is not enabled (Kirsch, FIG 3, item 68 and 70). Kirsch further teaches sending web pages with hyperlinks that can access other web pages (Kirsch, col 1, lines 30-65), but does not specifically mention that a shopping cart model is provided when the one click ordering method is disabled. Franklin teaches "The Web documents 310 stored on the merchant Web site 302 are preferably coded using HTML. The Web documents 310 contain HTML coding which, when received by a Web Browser 120, display various icons or buttons on the screen 114 of the consumer computer 102 along with text or pictures comprising the content of the Web document. As described above, these icons or buttons comprise selectable options which correspond to shopping-related transactions. In the preferred embodiment, the Web documents 310 offer consumers options to add product information to an electronic shopping basket, view products collected but not yet purchased, view products already purchased, enter payment information into an electronic wallet, place shipping addresses in an electronic address book, as well as order goods from Web-based merchants" (Franklin, col 14, lines 30-54). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Kirsch, providing

both shopping cart and "Buy Now" functionality, since APA teaches that one skilled in the art would know to add a shopping cart model to a web page (APA, page 6, lines 15-20) and that one skilled in the art would further appreciate that a single web page on the server system may contain a shopping cart model and a one-click model on a single web page (APA, page 6, lines 28,29).

**Claims 114-116,181,182 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch (US 5,963,915), in view of Levy and further in view of Official Notice.**

**In regards to claim 114-116,181,182,** the examiner takes Official Notice that displaying partial information to protect the user's personal information was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art to include in the combination of Kirsch and Levi, providing partial information, because providing only partial information has notoriously been known to protect the user's identity and personal information from theft.

***Response to Arguments***

Applicant's arguments with respect to claims 108-117,124,125,151-155,157,176-183 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment except as noted below:

Applicant argues that the previous rejection was improper in regards to claim 176, because particular features were not mapped to Kirsch. The examiner notes that the rejection had not been changed in that the claim was rejected for the same rationale as claim 108, which had been rejected in view of Kirsch. It is further noted that applicant was given ample time to respond with a clarification that was mailed on 10/31/2008. Therefore applicant's ability to respond to the office action was not substantially affected. However, a review of applicant's amendment filed 7/24/2008 did not constitute an amendment that introduced new claim features that would necessitate finality, and for that reason the previous finality is withdrawn. The new features it is noted, provided in the amendment filed 12/29/2008, amend the claims in a manner that necessitates a final reject.

**In regards to claims 124,125,157,** applicant argues that since the information is displayed then there is a positive recitation. The examiner disagrees and notes that it would seem that Applicant misunderstood the rejection. It is clear that Kirsch teaches the functional aspect of displaying information on a web page in the form of graphics and text. The point of the rejection is that the information "indicated" on the display does not functionally distinguish the claim, because the information is not functionally related to the substrate of the invention and is therefore nonfunctional language.

**In regards to claims 114-116,181,182** applicant requests a reference to support the examiner's taking of official Notice of displaying partial information to protect the user's personal information. In response to this request the examiner provides Mitchell which teaches providing partial credit card and other personal information over the internet is important so that the information can be identified by a customer but is difficult for others to use the information illegally since only portions of the information are provided.

Applicant may argue that neither Kirsch nor Mitchell specifically teach partial shipping information, As noted supra, The combination of Kirsch and Mitchell teach providing partial information but does not specifically mention that there is partial shipping information provided. However, these differences are only found in the non-functional data stored. Data identifying shipping information that is provided partially to the customer is not functionally related to the substrate of the invention. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the invention as shown in the combination of Kirsch and Mitchell, because such data does not functionally relate to the substrate of the invention and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. See In re Kuhle, 526

F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

**P.O. Box 1450**

*Alexandria, Va. 22313-1450*

or faxed to:

**571-273-8300** [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

**571.272.3600**

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/  
Primary Examiner, Art Unit 3625

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